

REMARKS/ARGUMENTS

Claims 36-43 and 47-55 are pending in the present application. Claims 40, 48, and 51 have been amended to clarify the subject matter recited therein. The amendments do not add new matter and find support throughout the Specification and Figures. In particular, the amendments to claims 40 and 48 are supported in the Specification at page 8, line 25 to page 9, line 5. It is respectfully submitted that all of the presently pending claims are allowable for at least the following reasons.

Double Patenting

Claims 36-43 and 47-55 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of United States Patent No. 6,682,771 to Zhong et al. A terminal disclaimer is being filed with this amendment, as suggested by the Examiner, and therefore it is respectfully requested that the rejection be withdrawn.

35 U.S.C. § 112, 2nd ¶

Claim 51 is rejected under 35 U.S.C. 112, second paragraph. Claim 51 has been amended to depend from claim 37, which includes a second coating, and therefore it is respectfully requested that the rejection be withdrawn.

35 U.S.C. § 103(a)

Claims 36-42, 47-50, and 52-55 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 6,395,326 to Castro et al. (the Castro reference) in view of United States Patent No. 6,063,339 to Tisone (the Tisone reference). Applicants respectfully traverse.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), not only must the prior art teach or suggest each element of the claim, but the prior art must also suggest combining the elements in the manner contemplated by the claim. *See Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); *In re Bond*, 910 F.2d 831, 834 (Fed. Cir. 1990). The Examiner bears the initial burden of establishing a prima facie case of obviousness. M.P.E.P. §2142. To establish a prima facie case of obviousness, the Examiner must show, *inter alia*, that there is some

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suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. M.P.E.P. §2143. Applicants respectfully submit that these criteria for obviousness are not met here.

Independent claim 36 relates to a method for applying a coating to a medical appliance including, among other things, placing a first agent into a first chamber connected to a first solenoid fluid dispensing head. The device according to claim 1 also includes transporting the first agent from the first chamber to the first solenoid fluid dispensing head and forcing the first agent from the first solenoid fluid dispensing head onto the medical appliance to form a first coating.

It is respectfully submitted that neither of the Castro reference nor the Tisone reference provides any suggestion or motivation to modify or combine the Castro and Tisone references as proposed in the Office Action. “The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.” M.P.E.P. §2143, citing In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991). The Examiner asserts that it would have been obvious to employ in the Castro reference the disclosure of the Tisone reference, stating that “[i]t would have been obvious to one of ordinary skill in the art to use the solenoid type printhead of Tisone in Castro's method of using an inkjet printhead because Tisone teaches solenoid valve dispensers are commonly used for inkjet printing applications.” (Office Action at page 4, section 4). However, this type of conclusory reasoning for the modification of the applied references is insufficient to sustain an obviousness rejection. There is no suggestion in either the Castro reference or the Tisone reference providing a motivation to combine the references. Merely stating that two references are compatible does not provide a motivation to combine the references. The only motivation to combine the references comes from Applicants' disclosure.

Furthermore, Applicants respectfully submit that neither the Castro reference nor the Tisone reference discloses, or even suggests, forcing an agent from a solenoid fluid dispensing head onto a medical appliance to form a coating, as recited in claim 36. Neither reference discloses, or even suggests, coating a medical appliance with a solenoid fluid dispensing head. The discussion in the Castro reference relating to dispense assembly 22 apparently relates to an ink-jet printhead and a microinjector. (Castro; col. 8, ll. 53-67). However, there is no

suggestion in the Castro reference of a solenoid fluid dispensing head. Additionally, the Tisone reference apparently relates to dispensing patterns on substrates, surfaces, or receptacles. (Tisone; abstract). It is respectfully submitted that the two-dimensional objects apparently discussed in the Tisone reference do not disclose, or even suggest, coating a medical appliance, for instance a stent. Since the references cited do not disclose or suggest all of the features of claim 36, the combination of the references does not render unpatentable the subject matter of claim 36.

Claims 37-42, 47-50, and 52-55 depend from claim 36 and are therefore allowable for at least the same reasons as claim 36 is allowable.

Additionally, regarding claims 38 and 47, which recite that the thickness of the coating varies as a function of position on the medical appliance, it is respectfully submitted that this feature is not disclosed in the prior art. Applicants respectfully request a citation in support of the Examiner's rejection, or alternatively, that the rejection be withdrawn.

Claims 40 and 48 recite a coating communicating information about the medical appliance to an exterior of a body after implanting the medical appliance in the body. The Office Action equates communicating toxicity to surrounding cells with communicating information, as claimed. It is respectfully submitted that delivering toxic materials to a region surrounding an implant does not disclose, or even suggest, communicating information about the medical appliance, as claimed. As disclosed in the specification:

[a]nother useful application of this precise coating method may be to convey information, or an identification code on the appliance itself. This information or code may then be used to identify the source of the medical appliance and other history related to it for tracking purposes. Once implanted, the code, which may be a bar code, could be read though radiography, MRI or any other suitable invasive or non-invasive procedure.

(Specification, page 9, line 26 to page 10, line 2). As is apparent from the quoted passage, the information which is communicated identifies the medical appliance. The Castro reference, which apparently relates to the delivery of substances to a site, gives no suggestion of communicating information, as recited in claims 40 and 48. However, to facilitate matters, claims 40 and 48 have been amended to clarify the subject matter recited therein. Therefore, for this additional reason, claims 40 and 48 are allowable over the cited references.

Claims 43 and 51 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the Castro reference in view of the Tisone reference and further in view of United States Patent No. 6,287,628 to Hossainy et al. (the Hossainy reference). Applicants respectfully traverse.

Claim 43 recites that the at least one of the first coating and the second coating includes a radiopaque agent. The Hossainy reference apparently relates to a prosthesis that may include a radioactive substance. However, none of the references discusses, or even suggests, coating a medical appliance with a *radiopaque agent* using a solenoid valve. Therefore, the combination of the references does not render the subject matter of claim 43 unpatentable.

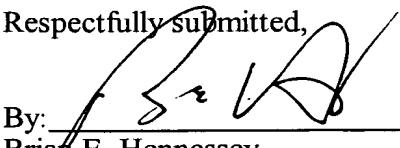
Claim 51 recites that the at least one of the first coating and the second coating includes a corrosive material that etches the medical appliance. The Hossainy reference apparently relates to a prosthesis that may include a radioactive substance. However, none of the references discusses, or even suggests, coating a medical appliance with a *corrosive material* that etches the medical appliance. Therefore, the combination of the references does not render the subject matter of claim 51 unpatentable.

For at least the reasons discussed above, withdrawal of the rejections under 35 U.S.C. §103(a) with respect to claims 36-43 and 47-55 is hereby respectfully requested.

CONCLUSION

Applicants respectfully submit that all of the pending claims of the present application are now in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

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